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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,995	08/15/2001	Noah J. Ternullo	12078-142	9105

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BOSTON, MA 02108

EXAMINER

NANO, SARGON N

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/929,995

**Applicant(s)**

TERNULLO ET AL.

**Examiner**

Sargon N Nano

**Art Unit**

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 Aug. 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) ¶   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6-Feb-04</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to application filed on Aug. 15, 2001. Claims 1 – 42 are pending examination.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 14-19, 23-31 and 35-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Holtz et al. U.S. Patent No. 6,760,916 (referred to hereafter as Holtz).

As to claim 1, Holtz teaches a method for distributing an advertisement associated with a service to a client device, said method comprising the steps of:

propagating said advertisement from a transmitter to said client device, said propagated advertisement forming an advertising signal containing advertising information ( see col.3, lines 41 – col.4, line 18 Holtz discloses sending a transmission segment and viewing an advertisement in that segment);

receiving said advertising signal at said client device ( see col. 11 lines 57 – 66 Holtz discloses receiving advertising link);

decoding said advertising signal to extract said advertising information (see col.11 line 63 – col. 12, line 13 Holtz discloses accessing the world wide web to get information); and

displaying said advertising information to a user of said client device (see col. 3 line 62 – col. 4, line 18 Holtz discloses displaying media production on client device).

As to claim 14 Holtz teaches the method of claim 1 wherein said advertisement is propagated as an optical signal through air (see col. 15 line 20 – 35, and fig. 3, Holtz discloses communication using optical interface).

As to claim 15, Holtz teaches the method of claim 14 wherein said optical signal has a wavelength in the range of substantially 850 nanometers to 1250 nanometers (see col. 15 line 20 – 35, and fig. 3, Holtz discloses communication using optical signal).

As to claim 16, Holtz teaches the method of claim 15 wherein said transmitter receives said advertisement over an Internet (see col. 23, line 12 – 26, Holtz discloses reception of broadcast over the internet).

As to claim 17, Holtz discloses the method of claim 15 wherein said transmitter receives said advertisement over a fiber optic network (see col. 14 lines 11 – 18, Holtz discloses sharing of resources using fiber optic transmission lines).

As to claim 18, Holtz discloses the method of claim 1 wherein said client device is a personal digital assistant (PDA) (see col.7, line 66 – col. 8, line 12, Holtz discloses wireless exchanges over communication infrastructure).

As to claim 19, Holtz teaches a method for conveying an advertisement from a transmitter having a link layer, said method comprising the steps of:

receiving said advertisement from a service (see col. 11 lines 57 – 66 Holtz discloses receiving advertising link);

formatting said advertisement for transmission to a client device operating within a context associated with said transmitter (see col.8 line 13 - 22 Holtz discloses the transmission of formatted media stream); and

conveying said advertisement to said client device over a communication medium (see col. 3 line 62 – col. 4, line 18 Holtz discloses displaying media production on client device).

As to claim 24, Holtz teaches the method of claim 19 wherein said client device includes a client device physical layer and a client device link layer compatible with said link layer in said transmitter (see col.4 lines 19 – 34 and figs. 3 and 4. Holts disclosed links among network devices).

As to claim 25, Holtz teaches a method for receiving an advertisement from a transmitter having an emitter link layer associated therewith, said method comprising the steps of:

receiving said advertisement at a communication interface (see col. 11 lines 57 – 66 Holtz discloses receiving advertising link);

decoding said advertisement to extract information contained therein (see col.3 line 62 – col. 4 line 34 Holtz discloses displaying of advertisement by different criteria);

processing said information (see col.9, lines 55 – 62, Holtz discloses the processing of the request); and

displaying said information to a user (see col. 3 line 62 – col. 4, line 18 Holtz discloses displaying media production on client device).

As to claim 26, Holtz teaches the method of claim 25 wherein said emitter link layer is compatible with a client device link layer associatively coupled to said communication interface (see col.8 lines 13 – 22).

As to claim 27, Holtz teaches the method of claim 25 wherein said information is displayed using a plug-in cooperatively associated with said advertisement (see col. 4, lines 35 – 42 Holtz discloses displaying advertised item).

As to claim 28, Holtz teaches the method of claim 27 wherein said plug-in further includes information about a preference of said user (see col.4 line 58- col. 5 line 7, Holtz discloses setting up of a template based on personal preference).

As to claim 29, Holtz teaches a method of utilizing executable code in a transmitter for providing an advertisement to a client device operating within a coverage area associated with said transmitter, said method comprising the steps of:

receiving said advertisement from a service provider, said advertisement further being associated with a service offered by said service provider (see col. 11 lines 57 – 66 Holtz discloses receiving advertising link) ;

formatting said advertisement for transmission to said client device (see col.8 line 13 - 22 Holtz discloses the transmission of formatted media stream); and

conveying said advertisement from said transmitter to said client device over a communication medium( see col. 3 line 62 – col. 4 , line 18 Holtz discloses displaying media production on client device).

As to claim 30, Holtz discloses the method of claim 29 wherein said advertisement is comprised of an XML element (see col.8 line 13 - 22 Holtz discloses the transmission of formatted media stream to support multimedia application).

As to claim 31, Holtz teaches the method of claim 30 wherein said advertisement further comprises:

service information enabling a user of said client device to make a decision about said service provider, said decision being based on said service information( see col. 35 line 45 – col. 36 line 50 Holtz discloses various pricing models to choose from);

data entry information informing said user about utilizing a service associated with said service provider (see col. 35 line 64 – col. 36 line 7 Holtz discloses price information of advertisement); and

contact information containing instructions for enabling said client device to communicate with said service provider ( see col. 3 lines 46 – 52, Holtz discloses the interaction between the user and the client server).

As to claim 35, Holtz teaches a method of utilizing executable code in a client device receiving an advertisement from a transmitter, said method comprising the steps of:

receiving said advertisement from an infrared communication signal conveyed from said transmitter and arriving at a communication interface associated with said client device, said advertisement containing at least a portion of a service offered by a service provider( see col. 11 lines 57 – 66 Holtz discloses receiving advertising link);

decoding said advertisement to extract information contained therein( see col.3 line 62 – col. 4 line 34 Holtz discloses displaying of advertisement by different criteria);

processing said information( see col.9, lines 55 – 62, Holtz discloses the processing of the request ); and

displaying said information to a user of said client device ( see col. 3 line 62 – col. 4 , line 18 Holtz discloses displaying media production on client device).

As to claim 36, Holtz teaches the method of claim 35 wherein said advertisement is comprised of an XML element (see col.8 line 13 - 22 Holtz discloses the transmission of formatted media stream to support multimedia application).

As to claim 37Holtz teaches the method of claim 36 wherein said advertisement further comprises:

service information enabling said user to make a decision about said service, said decision based on said service information( see col. 35 line 45 – col. 36 line 50 Holtz discloses various pricing models to choose from);

data entry information informing said user about utilizing said service(see col. 35 line 64 – col. 36 line 7 Holtz discloses price information of advertisement); and

contact information containing instructions enabling said client device to communicate with said service provider( see col. 3 lines 46 – 52, Holtz discloses the interaction between the user and the client server).

As to claim 38, Holtz teaches the method of claim 37 wherein said transmitter includes an emitter link layer (see col.8 lines 13 – 22).

As to claim 39, Holtz teaches the method of claim 38 wherein said client includes a client device link layer (see col.8 lines 13 – 22).

As to claim 40, Holtz teaches the method of claim 39 wherein said emitter link layer



is compatible with said client device link layer (see col.8 lines 13 – 22).

As to claim 41, Holtz teaches the method of claim 40 wherein said information about said service is displayed to said user if said client device is running a plug-in cooperatively associated with said service (see col. 4, lines 35 – 42 Holtz discloses displaying advertised item) .

As to claim 42, Holtz teaches the method of claim 41 wherein said plug-in further comprises information about a preference of said user( see col.4 line 58- col. 5 line 7, Holtz discloses setting up of a template based on personal preference).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-13, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holtz.

As to claim 2, Holtz teaches the method of claim 1 wherein said advertising information comprises:

an element comprising (see col. 3 line 62 – col. 4 , line 18 Holtz discloses displaying media production on client device).

service information enabling said user of said client device to make a decision about said service( see col. 35 line 45 – col. 36 line 50 Holtz discloses various pricing models to choose from);

data entry information informing said user about utilizing said service (see col. 35 line 64 – col. 36 line 7 Holtz discloses price information of advertisement); and

contact information containing instructions for enabling said client device to communicate with said service ( see col. 3 lines 46 – 52, Holtz discloses the interaction between the user and the client server).

Holtz does not teach XML. Official notice is taken as evident by Microsoft computer Dictionary 5<sup>th</sup> edition that it would have been obvious for the one of the ordinary skill in the art at the time of the invention to use XML because doing so would offer greater flexibility in organizing and processing information.

As to claim 3, Holtz teaches the method of claim 2 further comprising the step of selecting said service based on said advertising information (see col. 36 lines 51- 67 Holtz discloses the usage of advertising administration system).

As to claim 4, Holtz teaches the method of claim 3 further comprising the step of constructing a user interface for allowing said user to communicate with said client device (see col.15 lines 20 – 35 and fig 3. Holtz discloses communication interface between computer system and external device).

As to claim 5, Holtz teaches the method of claim 4 further comprising the step of receiving user inputs communicatively associated with said advertising information (see

col.16 lines 34 – 42, Holtz discloses the acknowledgement receipt of the user's specifications).

As to claim 6, Holtz teaches the method of claim 5 further comprising the step of formatting said user inputs and a portion of said advertising information into a user reply, said user reply for making said user inputs available to said service (see col.16, lines 49 – 53, Holtz discloses the assembling of order segment according to customized specifications).

As to claim 7, Holtz teaches the method of claim 6 wherein said user reply is received at said transmitter (see col. 16, lines 34 – 53, Holtz discloses the reception of the reply and the user reception of the of the customized program).

As to claim 8, Holtz teaches the method of claim 7 wherein said user reply is received as a wireless signal from said client device (see col.7 lines 48 – 65, Holtz discloses wireless transmission media).

As to claim 9, Holtz teaches the method of claim 7 wherein said user reply is received at said transmitter using a communication interface providing electromechanical contact between said client device and said transmitter (see col.14 lines 57 – 60 and fig.3, Holtz discloses the interface and communication infrastructure).

As to claim 10 Holtz teaches the method of claim 9 further comprising the step of receiving a service response from said transmitter, said service response including at least one member selected from the group consisting of a graphical representation of said service for display on said client device, executable code for allowing said client device to interact with said service, and text for display on said client device (see col3

line 62 – col.4, line 18, Holtz discloses the graphical or text presentation of the interaction).

As to claim 11 Holtz teaches the method of claim 6 wherein said user reply is received at a point-of-presence (POP) (see col. 45, line 58 – col. 46 line 9 and fig.2, Holtz discloses information server provider for promotion and advertisement).

As to claim 12, Holtz teaches the method of claim 11 wherein said user reply is received over a personal digital assistant (PDA) interface providing electromechanical contact between said client device and said POP (see col.7, line 66 – col. 8, line 12, Holtz discloses wireless exchanges over communication infrastructure).

As to claim 13, Holtz discloses the method of claim 12 further comprising the step of receiving a service response from said POP, said service response including at least one member selected from the group consisting of a graphical representation of said service for display on said client device, executable code for allowing said client device to interact with said service, and text for display on said client device (see col3 line 62 – col.4, line 18, Holtz discloses the graphical or text presentation of the interaction).

As to claim 20, Holtz teaches a method for conveying an advertisement from a transmitter having a link layer, said method comprising the steps of:

receiving said advertisement from a service ( see col. 11 lines 57 – 66 Holtz discloses receiving advertising link);

formatting said advertisement for transmission to a client device operating within a context associated with said transmitter ( see col.8 line 13 - 22 Holtz discloses the transmission of formatted media stream); and

conveying said advertisement to said client device over a communication medium ( see col. 3 line 62 – col. 4 , line 18 Holtz discloses displaying media production on client device).

Holtz does not teach XML. Official notice is taken as evident by Microsoft computer Dictionary 5<sup>th</sup> edition that it would have been obvious for the one of the ordinary skill in the art at the time of the invention to use XML because doing so would offer greater flexibility in organizing and processing information.

As to claim 21, Holts teaches the method of claim 20 wherein said advertisement includes:

service information enabling a user of said client device to make a decision about said service ( see col. 35 line 45 – col. 36 line 50 Holtz discloses various pricing models to choose from);

data entry information informing said user about utilizing said service (see col. 35 line 64 – col. 36 line 7 Holtz discloses price information of advertisement); and

contact information containing instructions for enabling said client device to communicate with said service ( see col. 3 lines 46 – 52, Holtz discloses the interaction between the user and the client server).

Claims 22, 23, 32, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holtz and further in view of Freitas et al. U.S. Patent No. 5,321,42 (referred to hereafter as Freitas).

As to claim 22 and 32, Holtz teaches a method for conveying an advertisement from a transmitter having a link layer, said method comprising the steps of:

receiving said advertisement from a service ( see col. 11 lines 57 – 66 Holtz discloses receiving advertising link);

formatting said advertisement for transmission to a client device operating within a context associated with said transmitter ( see col.8 line 13 - 22 Holtz discloses the transmission of formatted media stream); and

conveying said advertisement to said client device over a communication medium ( see col. 3 line 62 – col. 4 , line 18 Holtz discloses displaying media production on client device).

Holtz does not explicitly teach the limitation “transmitter as a diffuse infrared signal”. However Freitas teaches transmitter as a diffuse infrared signal (see col. 4 line 7- 24 Freitas discloses infrared signal). It would have been obvious to one of the ordinary skill in the art at the time of the invention to use infrared in Holtz invention as taught by Freitas because doing so would allow the user to send and receive files using wireless communication.

As to claim 23 and 33, Freitas teaches signal has a wavelength in the range of substantially 850 nanometers to 1250 nanometers (see col. 7 – 24 Freitas discloses operation within approximately 750 to 1000 nanometers).

As to claim 34, Freitas teaches infrared signal is generated by modulating an electric light (see col. 11 lines 7-24).

### ***Conclusion***

The Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

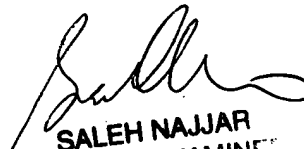
- Delivery Of Goods And Services Resultant from An Electronic commerce Transaction By way Of A Pack And Ship Type Company ,U.S. Patent No.6,601,038.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sargon N Nano whose telephone number is (571) 272-4007. The examiner can normally be reached on 8 hour.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272 - 4001 The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sargon Nano  
Patent Examiner  
Art Unit 2157  
Oct. 28 , 2004



SALEH NAJJAR  
PRIMARY EXAMINER